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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,630	06/27/2003	Per Martinsson	930010-2206	8456
20999	7590	09/16/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151.			PIZIALI, ANDREW T	
		ART UNIT	PAPER NUMBER	
		1771		

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/608,630	MARTINSSON ET AL.	
	Examiner Andrew T. Piziali	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 August 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12, 14-26 and 28-47 is/are pending in the application.
- 4a) Of the above claim(s) 5, 7-12, 19, 21-26 and 29-47 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4, 6, 14-18, 20 and 28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 4/5/2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed on 8/8/2005 has been entered. The objections to claims 13 and 27-28 have been withdrawn due to the cancellation of claims 13 and 27 and due to the amendment to claim 28.

***Election/Restrictions***

2. The applicant asserts that the election should be treated as an election with traverse because the applicant specifically stated that they elected with traverse. The examiner respectfully disagrees. Although the applicant did indeed state that the election was made with traverse, because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102/103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 3,800,019 to Parsey et al. (hereinafter referred to as Parsey).

Regarding claims 1-4 and 6, Parsey discloses a filament having a core surrounded by a plurality of respective outer layers of different colors (see entire document including column 2, lines 8-29).

Regarding claim 2, Parsey discloses that the core is made of a different material than the coatings (column 1, line 4 through column 2, line 30).

Regarding claims 3 and 4, the different colored outer coating layers indicate the level of wear associated with a wear level through the respective layers.

Regarding claim 6, although Parsey does not specifically disclose that the core and the respective layers are visibly distinguishable from one another, based on the different materials used for the core (synthetic or glass) compared to the coating (organic), it appears that the core would be visibly distinguishable from the respective layers.

7. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 6,653,943 to Lamb et al. (hereinafter referred to as Lamb).

Regarding claims 1-4 and 6, Lamb discloses a filament having a core surrounded by a

plurality of respective outer layers of different colors (see entire document including column 4, lines 19-35).

Regarding claim 2, Lamb discloses that the core is made of a different material than the coatings (column 1, lines 6-24 and column 4, lines 19-35).

Regarding claims 3 and 4, the different colored outer coating layers indicate the level of wear associated with a wear level through the respective layers.

Regarding claim 6, although Lamb does not specifically disclose that the core and the respective layers are visibly distinguishable from one another, based on the different materials used for the core (metal) compared to the coating (synthetic plastic material), it appears that the core would be visibly distinguishable from the respective layers.

***Claim Rejections - 35 USC § 103***

8. Claims 1-4, 6, 14-18, 20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,685,014 to Dapsalmon in view of any one of USPN 3,800,019 to Parsey or USPN 6,653,943 to Lamb.

Regarding claims 1-4, 6, 14-18, 20 and 28, Dapsalmon discloses a filament having a core (color A) surrounded by an outer layer (color B) (see entire document including column 1, line 63 through column 2, line 26). Dapsalmon does not specifically mention the use of a plurality of respective outer layers, but Parsey and Lamb each disclose that it is known in the wear detecting filament art that a core may be surrounded by a plurality of outer layers to indicate the degree of wear (see entire documents including column 2, lines 8-29 of Parsey and column 4, lines 20-35 of Lamb). It would have been obvious to one having ordinary skill in the

art at the time the invention was made to make the filament of Dapsalmon with a plurality of outer layers, because the plurality of outer layers allow for the indication of the degree of wear.

Regarding claims 2-4, 6, 16-18 and 20, Dapsalmon discloses that the core and the outer layer may be distinguishable from one another by different color (column 1, line 63 through column 2, line 26).

Regarding claims 14 and 28, Dapsalmon discloses that the filament may comprise a multifilament core-spun yarn (column 3, lines 57-60).

Regarding claims 15-18, 20 and 28, Dapsalmon discloses that the filament may be used to make a fabric (paragraph bridging columns 1 and 2).

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-4, 6, 14-18, 20 and 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,786,243 to Moriarty et al. (hereinafter referred to as Moriarty) in view of any one of USPN 3,800,019 to Parsey or USPN 6,653,943 to Lamb.

Regarding claims 1-4, 6, 14-18, 20 and 28, Moriarty discloses a filament having a

core (color A) surrounded by an outer layer (color B) (see claim 18). Dapsalmon does not specifically mention the use of a plurality of respective outer layers, but Parsey and Lamb each disclose that it is known in the wear detecting filament art that a core may be surrounded by a plurality of outer layers to indicate the degree of wear (see entire documents including column 2, lines 8-29 of Parsey and column 4, lines 20-35 of Lamb). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the filament of Moriarty with a plurality of outer layers, because the plurality of outer layers allow for the indication of the degree of wear.

Regarding claims 2-4, 6, 16-18 and 20, Moriarty discloses that the core and the outer layer may be distinguishable from one another by different color (claim 18).

Regarding claims 14 and 28, Moriarty discloses that the filament may comprise a multifilament yarn (claim 5).

Regarding claims 15-18, 20 and 28, Moriarty discloses that the filament may be used to make a fabric (claim 1).

#### *Response to Arguments*

11. Applicant's arguments filed 8/8/2005 have been fully considered but they are not persuasive.

The applicant asserts that the structures disclosed by Parsey and Lamb do not read on the current claims because Parsey and Lamb each teach a bundle of filaments that are surrounded by a plurality of respective layers, whereas the instant invention teaches a single filament that is surrounded by a plurality of respective layers. The examiner respectfully disagrees. The current claims do not exclude the presence of additional filaments that are also surrounded by a plurality

of respective layers. Parsey and Lamb simply discloses a plurality of the currently claimed filaments.

In response to applicant's argument that Parsey, Lamb, and Dapsalmon do not specifically mention that the filaments are capable of use in an industrial fabric used in papermaking and related industries, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Parsey, Lamb and Dapsalmon do not teach or suggest that the disclosed filaments are incapable of being used in an industrial fabric, therefore, it appears that the prior art structure is capable of performing the intended use. It is noted that the applicant has not shown, or attempted to show, that the filaments disclosed by the applied prior art are incapable of performing the intended use.

The applicant asserts that the structures disclosed by Parsey and Lamb do not read on the current claims because Parsey and Lamb supposedly teach that the layers do not function as an integral part of the primary purpose of the structure. The examiner respectfully disagrees. Applicant does not claim that the layers necessarily function as an integral part of the primary purpose of the structure.

In response to applicant's argument that Parsey and Lamb are both nonanalogous art to Moriarty, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case,

Parsey and Lamb are both in the field of applicant's endeavor, which is the field of wear detecting filaments, and Parsey and Lamb are also both pertinent to the particular problem with which the applicant was concerned, which is detecting the wear of a fiber.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

atp

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